

REMARKS

At the outset, Applicants wish to thank Examiner Low for the courtesies extended to Applicants' representatives during their telephonic interview on March 26, 2009. The substance of the interview is incorporated in the following remarks.

Summary of the Office Action

In the Office Action, claims 1-3 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,087,034 to *Kikkawa et al.* ("*Kikkawa*").

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,378,085 to *McVeigh*.

Claim 1 is objected to for certain informalities.

Summary of the Response to the Office Action

Applicants have amended claims 1 and 3 to better clarify the invention. Accordingly, claims 1-3 are presently pending.

Applicants have added new Fig. 13 to show the drive mechanism 30 recited in claim 1. No new matter has been introduced. Support for new drawing is found throughout Applicants' specification. The specification has been amended to address the 35 U.S.C. § 112, first paragraph, rejections.

Information Disclosure Statement

Applicants submitted an Information Disclosure Statement on September 24, 2008.

Applicants thank the Examiner for acknowledging the Information Disclosure Statement by initialing the PTO 1449 form and returning a copy to Applicants.

All Subject Matter Complies With 35 U.S.C. § 112, first paragraph

Applicants have amended the specification and drawings in order to expedite the prosecution of this case. Fig. 13 (sheet 14) is corrected to show only a drive mechanism 30 and electric motor 31. Support for the new drawing is found at least at page 10, ¶ [0011] and page 17, ¶ [0021] of the Applicants' specification as originally filed. No new matter has been introduced.

Applicants respectfully submit that claims 1-3 meet all the requirements of 35 U.S.C. § 112, and the rejection of claims 1-3 is now moot. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

All Claims Comply With 35 U.S.C. § 102(b)

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *McVeigh*. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *McVeigh* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Newly amended independent claim 1 recites, in part, "a clincher cam rotatable about a shaft including a cam surface engageable with the movable clincher so as to rotate the movable clincher, the clincher cam being driven through a drive link

directly operated by a drive mechanism for driving a staple.” Newly amended claim 3 recites, in part, “a cutter cam engageable with the movable cutter and capable of driving the movable cutter, wherein the clincher cam and the cutter cam are connected together as an integral body so that they can be rotated about the shaft with each other.” *McVeigh* fails to teach or suggest at least these features of claims 1 and 3.

The Office Action equates *McVeigh* with the claimed invention. But *McVeigh* does not show “a clincher cam rotatable about a shaft including a cam surface engageable with the movable clincher so as to rotate the movable clincher, the clincher cam being driven through a drive link directly operated by a drive mechanism for driving a staple,” as recited in claim 1. *McVeigh* does not disclose at least a clincher cam rotatable about a shaft. Applicants respectfully submit that *McVeigh* does not disclose a clincher cam rotatable about a shaft including a cam surface because the alleged clincher cam 55 and arcuate cam surface 60 in *McVeigh* simply translates up and down in the vertical direction by the activation of solenoid (SOL-3) driving an armature 58 and shaft 56. The arcuate cam surface 60 pushes down against anvils 50, 51 to facilitate cutting and clinching of a staple. There is no rotation of the alleged clincher cam 55 about a shaft in *McVeigh*. Accordingly, *McVeigh* fails to teach or suggest each and every feature of claim 1. Thus, the rejection of claim 1 should be withdrawn.

With respect to newly amended claim 3, *McVeigh* does not disclose at least “a cutter cam engageable with the movable cutter and capable of driving the movable cutter, wherein the clincher cam and the cutter cam are connected together as an integral body so that they can be rotated about the shaft with each other.” The Office Action identifies both the clincher cam and

cutter cam as element 55 and states they are integral. Cams may be considered integral if they rotate together as one while maintaining separate cam faces, but *McVeigh* shows only one alleged cam face 60 not two. As demonstrated above, there is no rotation of the alleged clincher cam 55 about a shaft in *McVeigh*. Thus, there is only one cam face shown in *McVeigh*, and the alleged integral cam is not rotated about a shaft. Therefore, *McVeigh* does not anticipate claim 3.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *McVeigh* does not teach or suggest each feature of independent claim 1.

Additionally, Applicants respectfully submit that dependent claims 2-3 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Kikkawa*. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Kikkawa* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Independent claim 1 recites, in part, "the movable clincher being disposed so as to be opposed to a striking position of a staple and to be rotatable; and a clincher cam rotatable about a shaft including a cam surface engageable with the movable clincher so as to rotate the movable clincher." *Kikkawa* fails to teach or suggest at least these

features of claim 1.

Applicants respectfully submit *Kikkawa* does not disclose either a “movable clincher being disposed so as to be opposed to a striking position of a staple and to be rotatable; and a clincher cam rotatable about a shaft including a cam surface engageable with the movable clincher so as to rotate the movable clincher.” The Office Action asserts that items 38, 38’ in *Kikkawa* are the alleged movable clincher. However, the alleged clincher 38, 38’ in *Kikkawa* is not opposed to its alleged striking position of the alleged staple as shown in Fig. 12(b) of *Kikkawa*. In order for *Kikkawa* to anticipate the present invention, the legs of the alleged staple (*i.e.*, resistor) must be opposed to the movable clinchers when in a striking position. The term *opposed* has a narrow meaning in the mechanical arts such as; to set (something) over against something else in place, or to set (two things) so as to face or be opposite to one another. See Unabridged Random House Dictionary, © Random House, Inc. 2009. Thus, *Kikkawa* does not anticipate the present invention because the alleged clincher 38, 38’ is not *opposed* to the alleged striking position of the alleged staple. Items 38, 38’ are actually located to the outside of the opposed position when the alleged staple is to be struck. Accordingly, *Kikkawa* fails to teach or suggest each and every feature of claim 1. Thus, the rejection of claim 1 should be withdrawn.

With respect to newly amended claim 3, *Kikkawa* does not recite, in part, “the staple legs penetrated through the binding sheets are guided into and between the movable cutter and fixed cutter, while the staple legs are engaged with the movable clincher.” Emphasis added. The Office Action has not shown the alleged staple legs are guided into position for cutting while they are engaged with the movable cutter. Thus, *Kikkawa* fails to teach or suggest at least these

features of claim 3. Accordingly, the rejection of claim 3 should be withdrawn.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Kikkawa* does not teach or suggest each feature of independent claim 1.

Additionally, Applicants respectfully submit that dependent claims 2-3 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION

This Amendment With RCE is being filed concurrently with a Request for Continued Examination. Claims 1 and 3 have been amended and new Fig. 13 provided.

In view of the foregoing, Applicants respectfully request reconsideration and allowance of all pending claims.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

EXCEPT for issue fees payable under 37 C.F.R. § 2.28, the Commission is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required,

including any required extension of time fees, or credit any overpayment to our Deposit Account

No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR
EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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